

Doc.#356702

REMARKS

In a final Office Action mailed on June 6, 2005 and given at three month shortened statutory period for reply the Examiner did the following:

1. Acknowledged that claims 11-23, 38-43 and 79-83 are pending in the application;
2. Objected to the drawings currently on file in the application;
3. Entered a Terminal Disclaimer submitted by the Applicants on January 11, 2005 and withdrew the rejection over US Patent No. 6, 033,907 to Williams and Patel; and
4. Rejected all pending claims under 35 USC 102(f) as being invented by another in view of US Patent No. 6,033,907 to Williams.

1. With respect to item 2 in the above the, Applicants will provide formal drawings fully addressing the objections of the Office to the drawings once the Applicants are notified that the claims of the application are in condition for allowance.

2. With respect to item 3 in the above, the Applicants wishes to thank the Examiner for making the earlier filed Terminal Disclaimer of record and for removing the obvious type double patenting (ODP) rejection over US Patent No. 6,033,907 to Williams.

3. With respect to item 4 in the above, the Applicants respectfully request that the Examiner remove this rejection in view of the attached declaration submitted by Dr. David A. Williams and the following arguments and explanations.

Response to Final Action
Serial No. 09/394,867
Docket No. 7037-377
Page 3 of 6

Doc.#356702

The Examiner notes that the '907 patent is to Williams and that it was filed for before the present application. The record of the present application shows that the current application is a continuation of US Patent Application Serial No. 08/556,891 filed on September 29, 1995, which is now the '907 patent. The present application, like the US Patent Application No. 08/556,891, is a continuation-in-part of earlier filed US application No. 218,355 filed on March 25, 1994 which is now US Patent No. 5,686,278 issued to Williams and Patel. Accordingly, the record demonstrates that the collaboration between the inventors of the instant application (Williams and Patel) pre-dates the filing of the '907 patent.

The Examiner cites section chapter 2100 of the MPEP which states that rejections under 35 USC § 102(f) do not require an inquiry into the relative dates of the reference and the application. See, Action pg. 4.

The applicants wish to point out that with respect to rejections under 35 USC §102(f) chapter 2100 section 2137 of the MPEP states that:

"Where there is a ... patent identifying the inventorship (MPEP §715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect the subject matter disclosed in the article or with respect to the subject matter disclosed, but not claimed in the patent so as to justify a rejection under 35 USC 102(f). However, it is incumbent upon the inventors named in the application, in reply to an inquiry regarding the appropriate inventorship under subsection (f), or to rebut a rejection under 35 USC 102(a) or (e) to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct that the references discloses subject matter invented by the applicant rather than derived from the author of patentee notwithstanding the authorship."

Response to Final Action
Serial No. 09/394,867
Docket No. 7037-377
Page 4 of 6

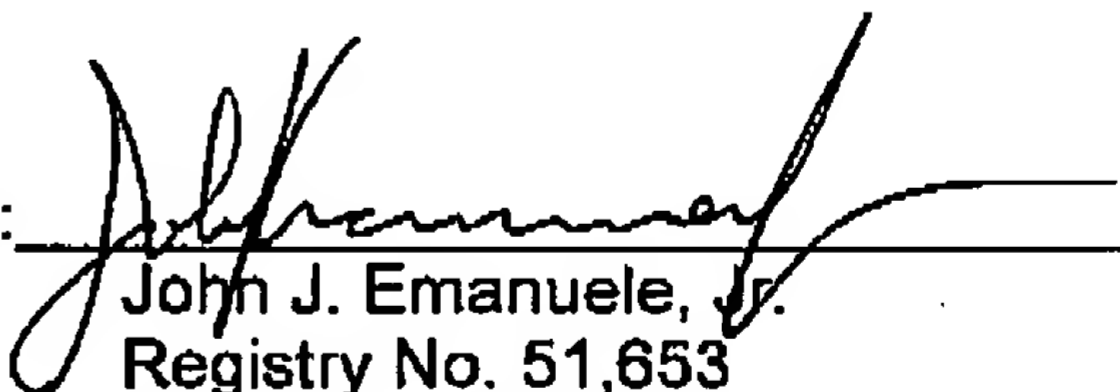
Doc.#356702

Accordingly, in response to the Examiner's inquiry concerning the derivation, of the present invention a Declaration signed by Dr. Williams stating that the present joint invention is not derived from his invention the '907 patent is attached.

In summary the record, priority claim, disclosures of US Application Serial No. 218,355 and the attached Declaration from Dr. Williams clearly show that the present invention is not derived from the '907 patent. Further, present invention has the same inventive entity, specifically Vikram P. Patel and David A. Williams, as priority US Patent Application No. 218,355, which was filed before the application that issued as US patent 6, 033,907. Accordingly, the applicants respectfully request that the rejection of pending claims 11-23, 38-43 and 79-83 under 35 102(f) be removed and that all claims be passed to allowance.

In view of the foregoing, reconsideration and allowance of this application containing claims 11-23, 38-43 and 79-83 is respectfully requested. The Examiner is invited to contact the undersigned attorney by telephone if there are any questions about this submission or other matters that may be readily addressed by telephone to expedite the allowance of this application.

Respectfully Submitted,

By: 
John J. Emanuele, Jr.
Registry No. 51,653
Woodard, Emhardt, Moriarty,
McNett & Henry LLC
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, Indiana 46204-5137
(317) 634-3456

Response to Final Action
Serial No. 09/394,867
Docket No. 7037-377
Page 5 of 6